

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed September 22, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. “Final” Status of Office Action**

Applicant notes that the Office Action, although being designated as “non-final” in the Office Action Summary sheet, identifies the Office Action as being “final” at the end of the Detailed Action because “Applicant’s amendment necessitated the new ground(s) of rejection.” Applicant presumes the “final” designation was added to the Office Action in error given that the amendment was submitted along with a Request for Continued Examination (RCE). If the “final” designation is intentional, however, Applicant objects to the final status as being premature.

### **II. Claim Rejections - 35 U.S.C. § 102(b)**

Claims 1, 3, 4, 7-13, 16-21, 24, 25, and 27-34 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Kumada* (U.S. Pat. No. 5,815,642). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Kumada reference. Applicant discusses the Kumada reference and Applicant's claims in the following.

**A. Claims 1, 3, 4, and 7-11**

Applicant's claim 1 provides as follows (emphasis added):

1. A method for notifying a user as to an inadequate color gamut, comprising:  
responsive to a print command, *accessing via a network* imaging data to be printed;  
identifying colors represented by the imaging data *from information contained within the imaging data*;  
comparing the identified colors with a color gamut of a printing device that is to print the imaging data; and  
notifying the user if one or more of the identified colors is not included in the color gamut of the printing device;  
*wherein the color identification occurs independent of consideration of monitor characteristics.*

Regarding claim 1, Kumada fails to teach several explicit limitations. First, Kumada does not teach accessing image data to be printed "via a network". Column 5, lines 1-5 of the Kumada reference, which were relied upon in the Office Action as teaching that limitation, provide:

As shown in FIG. 2, the image processing system in this example is comprised of a color monitor 1, a host computer 2 and a color printer 3.

The host computer 2 processes the image data, and causes the color monitor 1 to display its results, or the color printer 3 to print it.

*Kumada*, column 5, lines 1-5. As can be appreciated from the above excerpt, Kumada says nothing of any “network”. Moreover, Kumada clearly shows an arrangement in Figure 2 in which no network is present. Instead, the scanner 4, monitor 1, and printer 3 are each shown directly connected to a host 2 (i.e., host computer).

As a second matter, Kumada does not teach identifying colors represented by imaging data “from information contained within the imaging data”. Column 4, lines 30-58 and column 5, lines 45-48 of the Kumada reference relied upon in the Office Action provide as follows:

1. Conversion processing from scanner color space to monitor color space

To display photographic data read by the scanner with fidelity on the monitor.

2. Conversion processing from scanner color space to printer color space

To print photographic data read by the scanner with fidelity by the printer.

3. Conversion processing from monitor color space to printer color space

To print data such as characters or graphics created using the application software on the monitor with fidelity by the printer.

4. Conversion processing from printer color space to monitor color space

To preview the result printed by the printer on the monitor.

Herein, the color space of each of the above three devices depends on each device, with the reproducible color gamut being different.

Thus, a color gamut check function is provided for determining whether or not the input image data is reproducible with the target output device such as a monitor or a printer. This function can inform the user of the portion outside the color gamut. Or based on its judgement, image processing such as color space compression is performed, and all the input image data is converted within the color gamut of the output device.

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Herein, the target color is RGB data which depends on the display characteristics of color monitor 1 such as gamma characteristics, and is defined calorimetrically (with clear chromaticity values of R, G, B and White).

*Kumada*, column 4, lines 30-58 and column 5, lines 45-48. As can be appreciated from the above excerpts, Kumada says nothing of identifying colors represented by imaging data “from information contained within the imaging data”. Although Kumada does not explain what information is used to identify the colors, Kumada’s failure to actually teach identifying colors represented by imaging data from information contained within the imaging data means that Kumada cannot anticipate Applicant’s claim 1 under 35 U.S.C. §102.

As a third matter, Kumada does not teach that the color identification occurs “independent of consideration of monitor characteristics”. Regarding that limitation, the Office Action identifies column 5, lines 35-40 of the Kumada reference, which provide:

FIG. 4 is a flowchart of a processing for checking to see whether or not the color image data (R, G, B luminance data) created by the application software on the color monitor 1 is within the color gamut of color monitor 1 or color printer 3 in the color gamut check unit 28, and based on its result, determining whether or not to display on the color monitor 1.

*Kumada*, column 5, lines 35-40. Although the above excerpt does mention the color gamut of a monitor “or” color printer, it appears that the determination regarding the color gamut of the printer is still made in relation to the characteristics of the monitor. Specifically, *four lines after the above excerpt*, *Kumada* states the following in regard to the *same flowchart* discussed in the above excerpt:

Herein, the target color is *RGB data which depends on the display characteristics of color monitor 1* such as gamma characteristics, and is defined calorimetrically (with clear chromaticity values of R, G, B and White).

*Kumada*, column 5, lines 45-48 (emphasis added). In view of the above excerpt, it appears clear that in the process described in relation to Figure 4, which considers the color gamut of the monitor “or” the printer, the “display characteristics” of the monitor are taken into consideration because the RGB data “depends on” those characteristics. Accordingly, *Kumada* teaches the opposite of a color identification occurring “independent of consideration of monitor characteristics” as required by claim 1.

Turning to the dependent claims, *Kumada* also fails to teach several explicit limitations of those claims. Beginning with dependent claim 4, *Kumada* does not teach an “imaging extension” that comprises “one or more application programming instructions”.

Column 6, line 55 to column 7, line 6 of the Kumada reference only describes a “profile” for storing information used in a profile check. Nothing in that portion of Kumada’s disclosure describes anything like APIs.

Regarding dependent claim 8, Kumada is silent as to “Pantone” colors. Column 6, lines 16-20 do not say anything about Pantone colors.

Regarding dependent claim 10, Kumada is silent as to “ICC” profiles. Column 6, lines 26-32 do not say anything about ICC profiles.

Regarding dependent claim 11, Kumada does not teach presenting a printing warning to the user “that includes a message that explains that the printing device does not support a desired color”. First, Kumada’s practice of whiting-out portions of an image that are not supported by the color gamut of the monitor does not equate to a “message” that “explains” that the color is not supported. Second, the whiting-out only provides an indication that the color is not supported *by the monitor*. Kumada does not describe any indication provided to a user that a color is not supported by a “printing device”.

#### **B. Claims 12, 13, and 16-19**

Regarding independent claim 12, Kumada does not teach means for “accessing via a network imaging data to be printed”, means for identifying colors represented by the imaging data “from information contained within the imaging data”, or that the means for identifying identifies the colors “independent of characteristics of a monitor used to view the colors” for reasons described above.

Regarding dependent claim 13, Applicant refers back to the discussion of claim 4.

Regarding dependent claim 16, Applicant refers back to the discussion of claim 7.

Regarding dependent claim 19, Applicant refers back to the discussion of claim 10.

### **C. Claims 20, 21, and 28**

Regarding independent claim 20, Kumada does not teach logic configured to “access via a network imaging data to be printed”, logic configured to identify colors represented by the imaging data “from information contained within the imaging data”, or that the logic configured to identify identifies the colors “independent of characteristics of a monitor used to view the colors” for reasons described above.

Regarding dependent claim 21, Applicant refers back to the discussion of claim 4.

Regarding dependent claim 28, Applicant notes that Kumada clearly does not teach a “network-based service” comprising all the aspects described in independent claim 20 that is “hosted by a network-accessible printer”. First, as mentioned above, Kumada does not discuss networks. Second, Kumada says absolutely nothing about a printer hosting anything. Column 4, lines 19-24 of the Kumada reference, which were cited for support in rejecting claim 28, provide as follows:

FIG. 1 shows an example of color reproduction in a color management system. Herein, three basic color input/output devices are considered, including a color scanner, a color monitor and a color printer.

In the color management system, the color reproduction processing in consideration of the characteristics of such three devices is needed, and can be stated as the following four color space conversion processings as indicated by the arrow in FIG. 1.

*Kumada*, column 4, lines 19-24. Clearly, the above except neither discusses networks or a network-accessible printer that “hosts” any service. Moreover, Applicant notes that the only component described by *Kumada* that could be said to “host” a “service” of the type described by Applicant is *Kumada*’s host 2, which clearly comprises a computer *to which the printer 3 is connected*.

**D. Claims 24, 25, and 27**

Regarding independent claim 24, *Kumada* does not teach logic configured to “identify colors represented by the imaging data from information contained within the imaging data” for reasons described above. Perhaps even more significant, however, *Kumada* does not describe a “printer” that comprises any of the logic described in claim 24.

Regarding dependent claim 25, Applicant refers back to the discussion of claim 4.

Regarding dependent claim 27, *Kumada* does not teach that the “service” described in relation to independent claim 24 is “hosted by a network-accessible printer”. Again, *Kumada* does not describe his printer hosting anything, or that the printer is “network-accessible”.

**E. Claims 29-34**

Regarding independent claim 29, Applicant again notes that *Kumada* does not describe a printing device that performs any color gamut determination. Accordingly, *Kumada* fails to teach each limitation of independent claim 29.



As a further matter, Kumada fails to teach the limitations of dependent claims 30-32 and 34 for reasons described above.

#### **F. Conclusion**

Due to the clear shortcomings of the Kumada reference described in the foregoing, Applicant respectfully asserts that Kumada does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejections of the claims be withdrawn.

#### **III. Claim Rejections - 35 U.S.C. § 103(a)**

Claims 5, 6, 14, 15, 22, and 23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kumada* in view of *Such, et al.* ("Such," U.S. Pub. No. 2004/0207862). Applicant respectfully traverses this rejection.

Applicant notes that because the *Such* reference was published after Applicant's filing, the *Such* reference can only qualify as prior art as to Applicant's claims under 35 U.S.C. § 102(e). The *Such* reference, however, is not "by another" under 35 U.S.C. § 102(e) because the subject matter of the *Such* reference and Applicant's claimed inventions were owned by the same legal entity (i.e., the Hewlett-Packard Company) or were subject to an obligation of assignment to that legal entity when the inventions were made. In such a case, the cited reference may not be used against the Applicant's claims under 35 U.S.C. § 103. See 35 U.S.C. § 103(c) ("Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made,

owned by the same person or subject to an obligation of assignment to the same person.").

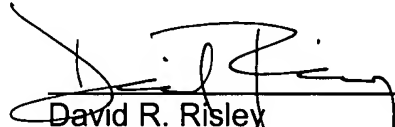
In view of the above, Applicant respectfully requests that the rejection be withdrawn.



### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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